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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,333	06/30/2003	Ramani R. Ranatunge	102258.153US	8773
24395	7590	10/19/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP THE WILLARD OFFICE BUILDING 1455 PENNSYLVANIA AVE, NW WASHINGTON, DC 20004			SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/608,333

**Applicant(s)**

RANATUNGE ET AL.

**Examiner**

Taofiq A. Solola

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 2-59 is/are pending in the application.
- 4a) Of the above claim(s) 3-13, 17-27, 40-54 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 2, 14-16, 28-39, 55-57 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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This Office action supersedes the previous non-final Rejection.

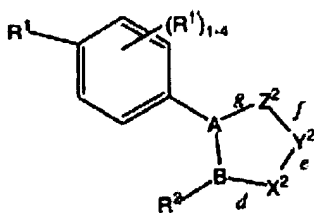
Claims 2-59 are pending in this application.

Claim 1 is cancelled.

Claims 3-13, 17-27, 40-54, 58 are drawn to non-elected invention.

### RESTRICTION REQUIREMENT

In the Paper filed 5/18/05 and the accompanied petition, applicant continues to traverse the final Restriction Requirement on the basis that all the inventions are related because they share a substantial structural feature and have a common utility. Applicant cited this formula as



:II

the substantial structural feature .

Applicant noted that the

common structural feature must have "at least one oxime group and/or hydraxone group. This is not persuasive because there is no oxime group and/or hydraxone group in the formula II above.

Applicant may not be clear about the meaning of "a" structural feature under MPEP 803.02

because applicant includes several variables such as A, B, R¹-R², X, Y, Z, etc which together makes formula II structural feature"s" instead of "a" single structural feature as required under

MPEP 803.02. Therefore, "a" structural feature shared by the compounds of formula II is phenyl,

which is not deemed substantial. Contrary to the requirement of MPEP 803.02 and applicant's

admission, no utility is cited relating to the phenyl ring in the instant application. Applicant also

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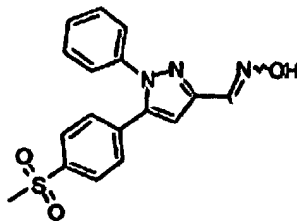
argues that the Examiner searched only the elected species. Nothing can be further from the truth because the record shows more than one species was searched. MPEP 803.02 requires the Examiner to search more than the elected species but states the search "will not be extended unnecessarily to cover all non-elected species."

Therefore the Restriction is deemed proper and hereby made FINAL. However, additional species have now been searched, the result of which is as stated herein below.

Applicant had elected compound A described at page 107, line 13 to page 110, line 18, of the specification. Therefore, claims 2, 14-16, 28-39, 55-57, 59 are being examined in part subject to the election made by applicant.

### *Status of Claims*

The Office has reviewed the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention encompasses all compounds within the scope of the claims, which fall into the same class and subclass as the elected compound, but may include additional compounds, which fall in related subclasses. Examination of the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common



classification results in the following:

A-B is N-C and -X<sup>2</sup>-Y<sup>2</sup>-Z<sup>2</sup>-

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is  $=\text{CR}^4-\text{CR}^5=\text{N}-$  or  $=\text{CR}^{2'}-\text{CR}^5=\text{N}-$  in formula II. Sides d and f are double bonds, sides e and g are single bonds; R1, R1', R2' and R4 are as defined in claim 59. R5 is as defined in claim 59 but limited to those having the hydroxyimino group (oxime) as in the above formula. This meets the requirement of the invention that the compounds must have at least one oxime and/or hydrazone group. R2 is methylsulfonylphenyl as shown in the formula above, which is not within the definition of R2 in claim 59. However, if A-B is N-N, it must have a double bond on one of the Ns according to the species elected by applicant. Therefore, appropriate correction is required.

As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claims 2, 14-16, 28-39, 55-57, 59 are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the examined invention, would not render obvious the non-examined subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 2, 14-16, 28-39, 55-57, 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Talley et al., US 5,760,068.

Talley et al., disclose generic compounds of formula (II) and several species and compositions thereof. See the abstract, the examples, Table 1 and the claims.

Claims 2, 14-16, 28-39, 55-57, 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Lohray et al., WO 2000066562.

Lohray et al., disclose generic compounds of formula (II) and several species and compositions thereof. See the abstract, the examples, the Table and claims.

55, 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Desiraju et al., Molecules [online computer file] (2000), Vol. 5, No. 7, pages 945-955.

Desiraju et al., disclose the marked compound on the attached abstract.

Claims 2, 14-16, 28-39, 55-57, 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Isakson et al., WO 9711704.

Isakson et al., disclose generic compounds of formula (I) and several species and compositions thereof. See the abstract, the examples, the Tables and claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 2, 14-16, 28-39, 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desiraju et al., Molecules [online computer file] (2000), Vol. 5, No. 7, pages 945-955.

Applicant claims compositions of compound of formula II.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Desiraju et al., teach the marked compound on the attached abstract and its method of use as inhibitor of cyclooxygenase.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between the instant invention and that of Desiraju et al., is that Applicant claims the compositions while Desiraju et al., do not teach the composition.

*Finding of prima facie obviousness---rational and motivation (MPEP §2142.2413)*

However, for the compound to be used as inhibitor of cyclooxygenase it must be used in the form of a composition. Therefore, the instant invention is prima facie obvious from the teaching of Desiraju et al. One of ordinary skill in the art would have known to claim the composition at the time the invention was made. The motivation is from the teaching of Desiraju et al., that the compound is useful as inhibitor of cyclooxygenase.

***Objection***

Claims 2, 14-16, 28-39, 56-57 are objected to for being depending from a subsequent claim. Under US patent practice dependent claims must depend from a precedent claim.

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***Allowable Subject Matter***

Claims 2, 14-16, 28-39, 55-57, 59 are objected to for containing non-elected subject matter. To place the application in condition for allowance, all claims drawn to non-elected subject matter must be cancelled and claims 2, 14-16, 28-39, 55-57, 59 must be amended within the scope of allowable subject matter set forth above under Status of Claims.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER  
*Kamal Saeed*

Group 1626

October 1, 2005